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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,096	02/13/2001	Raffi Sheekookian	1999-0269	9733

7590

07/27/2004

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EXAMINER

STILES, WESLEY L

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 07/27/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,096

Applicant(s)

SHEEKOOKIAN, RAFFI

Examiner

Wesley Stiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Drawings

1. The formal drawings were received on June 28, 2001. These drawings have been reviewed and are accepted by the examiner.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

3. The disclosure is objected to because of the following informalities: "carrier=s" should apparently be "carrier's" in line 10 of page 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuen (US 2002/0098834). Regarding claim 1, Yuen discloses a method of connecting telephone services to a digital TV set-top box. Yuen discloses a process by which the system scans for and then synchronizes with the downstream channel, in a process that is initiated by the set-top box. As stated in paragraph 28, the set-top box signals the cordless telephone base unit, telling it when to establish the telephone connection. In addition, the system of Yuen also synchronizes with the service provider's telephone

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network (see paragraph 36). The process of establishing a telephone connection to the service provider's telephone network inherently calls for the synchronization with a downstream channel and the telephone network itself. Without these two steps, a connection with the telephone network cannot be made. Yuen also discloses the ability of the system to allow the service provider to download information to the set-top box (see paragraph 62), as well as user execution of those programs (as shown in paragraph 64). Users may also enter data selections (see paragraph 65), store selections (see paragraph 61), and use those selections via the set-top box to initiate a telephone service (as shown in paragraphs 69 and 70 as the ability to enable/disable features such as call waiting and caller ID through the set-top box). The information disclosed by Yuen covers all limitations present in claim 1.

6. Regarding claim 4, Yuen discloses a microprocessor (reference number 204 of figure 4) which provides the data and commands for each function of the set-top box. Referring to paragraphs 59-61 of Yuen, he discloses an example of how information and instructions are passed back and forth through the system via the microprocessor in the example of buying an item shown on the television. Since the set-top box of Yuen comprises a capable microprocessor with memory that drives the functionality of the system as a whole, it is inherent that software containing code to perform each function must be present. Every function mentioned above must therefore have accompanying computer-executable code. Thus, the system disclosed by Yuen meets all limitations of claim 4.

7. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Brodigan (U.S. Patent 6,219, 355). Brodigan teaches a system where a user can request telephone service changes through the television receiver. See column 7, lines 36-40. The system of Brodigan meets all of the limitations of claim 5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen in view of Martino (US 2002/0075231).

10. Regarding claim 2, Yuen discloses all of the stated limitations except for the ability to remove the storage medium of the set-top box.

11. In analogous art, Le Berre (US 5,748,732) teaches the use of a smart-card, which can be inserted into the receiver to store "data relating to the entitlements of the user". See column 1, lines 5-13 of Le Berre.

12. At the time of the invention, it would have been obvious to one of ordinary skill in the art to apply the removable storage of Le Berre to the multi-use set-top box of Yuen. The motivation for do so would have been to increase portability and allow the user to receive their subscribed services at more than one receiver. Therefore, it would have been obvious to on of ordinary skill in the art at the time the invention was made to modify Yuen to include the removable storage medium of Le Berre for multiple receivers to achieve the same functionality of their main receiver at multiple locations in their home.

13. Regarding claim 3, the combination of Yuen and Le Berre disclose the claimed limitation, wherein Le Berre teaches a card is inserted into one of the units, receives program information from that unit, and it then inserted into a second unit to allow it to function as the first. This configuration is shown in figure 1, with an accompanying description in column 3, lines 20-35. The process of inserting one card into multiple receivers is disclosed in column 4, lines 40-42. Thus, when the user removes the card from the first set-top box and inserts it in the second, the second receives the stored attributes of the first.

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Bellamy U.S. Patent 6,209,025 discloses a set-top box which is connected to a telephone network.
- b. Lee U.S. Patent 5,917,892 discloses a television receiver that functions as a telephone answering machine.
- c. Martino US 2002/0075231 discloses a set-top box with a removable storage medium.
- d. Reams U.S. Patent 6,457,177 discloses a set-top box which can be used to transmit, receive, and store telephone data.
- e. Voois et al. U.S. Patent 6,215,515 discloses a videophone system.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Stiles whose telephone number is (703) 308-6107. The examiner can normally be reached on 7:00-4:30, out of the office on alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703)305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WLS

7/16/04


VIVEK SRIVASTAVA
PRIMARY EXAMINER